

1.136(a)(3)). If this amount is incorrect, please refer to the Deposit Account Authorization previously filed for this application.

### REMARKS

In accordance with 37 C.F.R. § 1.121 to be amended and the February 25, 2003 Official Gazette, a complete listing of all claims in the application is attached. No claims are amended.

Claims 1- 29 remain in the application. Claims 9-20 have been allowed. It is respectfully submitted that the Claims are in condition for allowance. The following remarks are offered in support of allowance of Claims 1- 8 and 21-29. Reexamination and reconsideration of the application in light the following remarks are respectfully requested.

**Claim 29.** Once again, as pointed out in the August 4, 2003 Amendment Under 37 C.F.R. §1.111, the Office has made no reference to **Claim 29**. This claim was added at the same time as Claim 28 in the March 14, 2002 Amendment Under 37 C.F.R. §1.111. Claim 29 is a dependent claim to Claim 28. As stated in the MPEP §707.07(I), “[i]n every office action, each pending claim should be mentioned by number, and its treatment or status given.” Applicants respectfully request that this claim be included in any new action.

### *The § 102 Rejections*

**Baxter et al.** Claims 21, 22, and 27 were rejected under 35 U.S.C. §102 (b) as being anticipated by Baxter *et al.*. The Office maintained the prior rejection, stating that the phrase “wherein said wood-building material without said composition would be susceptible to termite infestation” offers no patentable significance to a composition claim. Applicants respectfully disagree. The phrase restricts the types of materials that would fall within the invention of Claim 21. The wood building material must be susceptible to termite infestation. The phrase is not a function or a use of a composition, but limits the type of composition that would be included in Claim 21. The composition must be a material that is susceptible to termite infestation, e.g., some form of cellulose.

The Office earlier cited Baxter as teaching adding nootkatone to water (aqueous citric acid). The Office stated that water “is considered a wood building material as well as a substrate.” The

Baxter reference does not teach or suggest adding nootkatone as a method to protect any material from termites. The Baxter reference does not teach or anticipate adding nootkatone to any material that is inherently susceptible to termite infestation. Applicants disagree that a “wood building material” would include water. Water has neither wood products nor derivatives of wood in it. Water is not a material that termites would otherwise infest and thus would not be included in the Claim 21. It is respectfully submitted that the Baxter reference neither teaches nor suggests the composition of Claim 21, the independent claim. If this claim is not anticipated, then the dependent claims 22 and 27 are not anticipated.

**JP 61033129.** Claim 28 was rejected under 35 U.S.C. §102(b) as being anticipated by JP 61033129. The Office maintained the prior rejection, stating that the phrase “wherein said substrate material without said composition would be susceptible to termite infestation” offers no patentable significance to a composition claim. Applicants respectfully disagree. The phrase restricts the types of materials that would fall within the invention of Claim 28. The substrate material must be susceptible to termite infestation. The phrase is not a function or a use of a composition, but limits the type of substrate material that would be included in Claim 28. The composition must be a material that is susceptible to termite infestation, e.g., some form of cellulose.

The Office stated that this reference teaches a method of using bicyclovetivenol as a local anesthetic, and considered the human body as a “substrate.” Applicants respectfully submit that independent Claim 28 describes a composition for a “protective barrier against termite infestation” and defines the barrier as comprising in part a “substrate material,” which would otherwise be susceptible to termite infestation. The word “barrier” as used in claim 28 would not include a human body. Applicants respectfully submit that this reference neither anticipates, teaches nor suggests the composition of Claim 28.

**Nishimura et al.** Claim 28 was rejected under 35 U.S.C. §102(b) as being anticipated by Nishimura *et al.* The Office maintained the prior rejection, stating that the phrase “wherein said substrate material without said composition would be susceptible to termite infestation” offers no patentable significance to a composition claim. Applicants respectfully disagree. The phrase restricts the types of materials that would fall within the invention of Claim 28. The substrate

material must be susceptible to termite infestation. The phrase is not a function or a use of a composition, but limits the types of materials that are included in Claim 28. The composition must be a material that is susceptible to termite infestation, e.g., some form of cellulose.

The Office stated that Nishimura “teaches a method where zizanol is added to ketones and acids” and that “ketone and acid are considered materials or substrates.” The Nishimura reference, as indicated by the title, is a reference directed to the “Volatile constituents of vetiver oil. Identification of phenol derivatives.” The authors state that they determined in five vetiver oils certain alcohols, ketones and acid compositions. Applicants disagree that ketones or acids would be considered covered by independent claim 28. Claim 28 requires the material or barrier to be susceptible to termite infestation without the addition of the stated compounds. Liquids are not considered such materials. Nishimura does not anticipate, teach or suggest the composition of Claim 28.

***Kashihara.*** Claims 21, 22, and 27 were rejected under 35 U.S.C. §102(a) as being anticipated by Kashihara. The Office maintained the prior rejection, stating that the phrase “wherein said wood-building material without said composition would be susceptible to termite infestation” offers no patentable significance to a composition claim. Applicants respectfully disagree. The phrase restricts the types of materials that would fall within the invention of Claim 21. The wood building material must be susceptible to termite infestation. The phrase is not a function or a use of a composition, but limits the types of wood building material that are included in Claim 21. The composition must be a material that is susceptible to termite infestation, e.g., some form of cellulose.

The Office stated that Kashihara teaches a method of adding nootkatone to water or plastic, and that either “water or plastic is considered a material as well as a substrate.” Kashihara describes a method that uses nootkatone to “dissolve plastics.” Applicants respectfully submit that Kashihara does not anticipate independent claim 21, which describes adding nootkatone for “protecting a material from termite infestation” and for “a protective barrier against termite infestation.” Applicants disagree that water, or any liquid, would be considered a “material” or “barrier” as used in Claim 21. Moreover, the use of nootkatone to “dissolve” plastic would by necessity not be the same use as protecting the material from termite infestation. Kashihara neither anticipates, teaches

nor suggests the composition of Claim 21 as amended, or of the claims dependent on it (Claims 22 and 27).

It is respectfully submitted that the §102 rejections should be withdrawn.

### ***The § 103 (a) Rejections***

***Baxter.*** Claims 22 - 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Baxter *et al.*. Claims 22 -24 depend from Claim 21. Claim 21 is neither anticipated nor made obvious by Baxter *et al.* and thus the Claims that depend from Claim 21 would neither be obvious nor anticipated.

***Kashihara.*** Claims 22 - 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashihara. Claims 22 -24 depend from Claim 21. Claim 21 is neither anticipated nor made obvious by Baxter *et al.* and thus the Claims that depend from Claim 21 would neither be obvious nor anticipated.

***Takagi.*** Claims 1, 2, 4, and 5 were for the first time rejected under 35 U.S.C. §103(a) as being unpatentable over Takagi (WO 99/25196; 5/27/99), a reference submitted by Applicants with the original IDC on May 23, 2001. The Office stated that Takagi teaches that nootkatone is used to repel indoor hematophagous insects, and that one of ordinary skill in the art would have been expected to use nootkatone to repel termites since termites are insects. The prosecution of this technology began with a Takagi reference cited against other claims (9, 15-17, 21-24), but not Claims 1-8. (See May 07, 2001 Office Action). In the next Office Action, the Takagi reference was retained **only** against Claims 21-24. (See June 04, 2002 Office Action). In the next Office Action, there was no reference to Takagi (See March 03, 2003 Office Action). Now in the fourth Office Action, we are back to this reference. Although Claim 1 was amended in the last amendment, this amendment did not form a basis for this new rejection based on Takagi. As stated in the MPEP §707.07(g), “[p]iecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references.” See also, 37 C.F.R. §1.104(b), “[t]he examiner’s action will be complete as to all matters . . . .” (Exceptions deleted since not apply). Even though Applicants respectfully disagree with the citation of this reference in this fourth office action, as discussed below, the reference neither teaches nor suggests the invention as claimed in Claim 1.

Takagi *et al.* describe an invention for “an indoor hematophagus insect repellent,” specifically blood-sucking (“hematophagus”) mosquitos. Termites are not hematophagus insects, but are subterranean insects that eat primarily cellulose. See, e.g., Specification, page 1, line 21 to page 2, line 3. One skilled in the art would not expect termites to be repelled by the same compound that repels mosquitos, due to the differences in the life style and eating preferences of the two. This is especially true for termites, as explained in the Specification, page 2, lines 7: “The search for a new repellent or termiticide is difficult because studies have shown that termites show unexpected sensitivity to chemicals, sensitivity that differs from that of other insects. For example, phenoxyethanol has been shown to be a trail-following substance; and naphthalene, a toxicant for most insects, was found to be used as a fumigant by termites for their nests at concentrations that would kill fire ants.” (References omitted). Thus, a person skilled in the art would not have an expectation of success or even a motivation to try nootkatone as a repellent for termites based on its aerial effects on a blood-sucking (hematophagus) mosquito. Applicants respectfully submit that this reference neither teaches nor suggests the invention as claimed in the independent Claim 1, nor in any of the claims that depend from Claim 1 (Claims 2,4, and 5).

It is respectfully submitted that the § 103 rejections should be withdrawn.

### ***Claim Objections***

Claims 3, 6-8, and 25-26 were objected to as being dependent upon a rejected base claim. For the reasons discussed above, the rejections to Claims 1 and 21 should be withdrawn, and the base claims allowed. If the independent claims are neither anticipated nor obvious, then the dependent claims should be allowed.

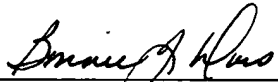
Applicants respectfully submit that these objections should be withdrawn.

### **Conclusion**

For the reasons discussed, it is respectfully submitted that all pending claims are in condition for allowance. If the Office disagrees with any of these remarks, or if other issues arise that may

present an obstacle to allowance, the undersigned requests a telephone interview to discuss such matters before further action is taken to see if an agreement can be reached on moving this case to issuance. If no agreement can be reached, because the case has now gone through four office actions, Applicants intend to file a Notice of Appeal to appeal any rejected claims. Allowance of Claims 1-8 and 21-29 at an early date is solicited. Claims 9-20 have already been allowed.

Respectfully submitted,



---

Bonnie J. Davis  
Registration No. 41,699  
Taylor, Porter, Brooks & Phillips, L.L.P.  
P.O. Box 2471  
Baton Rouge, Louisiana 70821  
(225) 381-0236  
March 30, 2004